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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,402	11/28/2000	Tina M. Nocera	0015.10	6268

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EXAMINER
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SUBRAMANIAN, NARAYANSWAMY

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/723,402

Applicant(s)

NOCERA ET AL.

Examiner

Narayanswamy Subramanian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 23,27-29 and 32-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22,24-26,30 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This office action is in response to the communication filed on November 12, 2004. The Examiner acknowledges election with traverse of claims 1-18, 21, 22, 24-26 and 30-31.

Applicant's arguments for combining Group I and Group II claims for examination purposes are persuasive and hence the Examiner withdraws the restriction between Group Group II and I.

However Applicant's arguments for combining other groups is not persuasive and hence those restrictions are maintained as discussed below. Claims 23, 27-29 and 32-34 are withdrawn from consideration as being drawn to a non-elected invention See 37 CFR 1.142(b). Applicants are respectfully advised to cancel the non-elected claims in response to this office action. Elected claims 1-22, 24-26 and 30-31 have been examined. The objection, response to amendments, rejections and response to arguments are stated below.

#### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The abstract provided exceeds 150 words. Correction is required.

#### ***Response to Amendment***

3. Applicant's arguments for combining Group I and Group II claims for examination purposes is persuasive and hence the restriction between Group Group II and I is withdrawn by the Examiner. For the purpose of examination and discussion below, claims 1-22, 24-26 and 30-31 will be grouped together under Group I.

However Applicant's arguments for combining other groups is not persuasive for the reasons given in the last office action and for the additional reasons given below.

The reason for omitting steps in each group of claims in the last office action is because these omitted steps were common to all the groups. The focus of the discussion in the last office action was to highlight the differences between the groups so that it is apparent that these groups are different. Hence only those steps, which highlighted the differences between the different groups, were retained in the discussion.

Group I (claims 1-22, 24-26 and 30-31) drawn to a method of providing to a user a plurality of answer-options to an issue-question relating to personal finance and investment that can be used in situations where the issue-questions are submitted in a certain fixed format (although this is not explicitly claimed it is implicit in the claim) and where these issue-questions do not require editing for proper grammar and form. On the other hand Group III (claim 23) is drawn to a method of providing to a user a plurality of answer-options comprised of an expert opinion and a prudent-investor opinion on an issue-question and relating to personal investment and finance that can be used in situations that calls for submitting an issue-question in free-form and editing the issue-question for proper grammar and form. Hence group I claims have a utility different from that of group III. In both these groups the logic for matching the questions and answers could be any logic that does the matching. Group IV (claims 27-29 and 32-34) is drawn to a method of providing to a user a plurality of answer-options comprised of an expert opinion and a prudent-investor opinion on an issue-question and relating to personal investment and finance that can be used in situations where matching is done only using a combination of Bayesian inference and information theory. Hence group I and group III claims have utilities

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different from that of group IV. For these reasons and those discussed in the last office action the restriction/election requirement of other groups (III and IV) made in the last office action are maintained. Applicants are respectfully advised to cancel the non-elected claims in response to this office action.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention.

5. Regarding claims 1, 6, 14 and 19 the phrase "and the like" renders the claim(s) indefinite because the claims include elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable. Claims 2-5, 7-13, 15-18, 20-22 and 24-26 are rejected because they depend on a rejected independent claim. See MPEP § 2173.05(d).

***Double Patenting***

6. The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time-wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground

provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-22, 24-26, 30 and 31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of Nocera (U.S. Patent 6,193,518). Although the conflicting claims are not identical, they are not patentably distinct from each other because they recite the means or steps that are substantially the same and that would have been obvious to one of ordinary skill in the art.

Claim 1 recites the same steps of claim 1 of Nocera with the phrase “child development” replaced by the phrase “personal finance and investment”, the term “parent-expert opinion” replaced by the phrase “prudent-investor opinion”. Although these phrases are not in the same field of endeavor as the ones in the patented case, the method of the patented case is reasonably pertinent to the problem with which the applicant is concerned, namely “providing to a user a plurality of answer-options to an issue-question”. Hence these changes would have been obvious to one with ordinary skill in the art. Also the additional limitation “said opinion being from persons having actual, hands-on, practical experience with specific financial issues, situations, regardless of whether that person is actively and regularly engaged in investment matters, or maintains an active portfolio of investment properties, for each issue-question” would have been obvious to one with ordinary skill in the art of personal finance and investment.

Claims 2-20 recite the same steps of claims 2-20 respectively of Nocera with appropriate replacements as noted in the discussion of claim 1 above.

Claim 30 essentially recites the same step of claim 6 of Nocera with the exception of the limitation of "providing to a computer output device" to communicate with the user. This limitation would have been obvious to one with ordinary skill in the art.

With regard to claims 21, 22, 24-26 and 31, it would have been obvious to one with ordinary skill in the art at the time the invention was made to include the steps: wherein a copy-editor evaluates each answer-option for content, and eliminates those answer-options with the same content, such that only answer-options which contain unique opinions are displayed to the user; wherein each answer-option is assigned a content code and wherein more than one answer-option has the same content code, only one of the answer-options with the same content code is selected for display to the user; further including the step of assigning a preference code to each answer-option; further including the step of asking the user a series of questions, designed to identify the user's preferences, and assigning to the user a preference code; and further including the step of filtering the answer-options to the selected issue-question, to include only those answer-options coded with the user's preference code. These steps provide the user with the most appropriate answer to his/her question, while blocking out other unnecessary information or information overload.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-22, 24-26 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmonsees (US Patent 5,842,221) in view of Tarbox (US Patent 6,154,732).

With reference to claims 1-22, 24-26 and 30-31, Schmonsees discloses methods of providing to a user answer-options to an issue-question, in a computer having a processor, an input device, a memory storage device and an output device, said method comprising the steps of: identifying and storing in the memory storage device a plurality of topics relating to a field of endeavor; developing and storing in the memory storage device a plurality of issue-questions directed to each of the stored topics; developing and storing in the memory storage device an answer for each issue-question; selecting, by the user via the input device, a topic; selecting, by the user via the input device, an issue-question directed to the selected topic; and providing to the computer output device answer-options to the selected issue-question, that is polycentric and tailored to said issue-question (See Schmonsees Abstract, Column 2 lines 8-20, and claims 7 and 8). The answers and links corresponding to the selected question are interpreted to include response that is polycentric and tailored to said issue-question.

Schmonsees does not explicitly disclose the steps wherein the field of endeavor is personal investment and finance and the answers include an expert opinion and a prudent-investor opinion for each issue-question.

Tarbox discloses the steps wherein the field of endeavor is personal investment and finance (See Tarbox Abstract and Column 1 lines 5-16) and the answers include an expert opinion (See Tarbox Column 2 lines 27-30) and a prudent-investor opinion (See Tarbox Column



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4 lines 13-17) for each issue-question. The advice from the investment advisor is interpreted to include a prudent-investor opinion.

Both Tarbox and Schmonsees are concerned with the problem of providing advice and answers to users questions. It would have been obvious to one with ordinary skill in the art at the time of invention to include steps taught by Tarbox to the invention of Schmonsees. The combination of the disclosures taken as a whole suggests that it would have helped a user get answers from experts to his/her questions in the field of personal finance and investments in a dynamic fashion. As for the dependent claims, the features in these claims are either taught by the combination of the disclosures of Tarbox and Schmonsees or are old and well known in the art. These features increase the options available to the user in seeking the answers to his/her questions in a dynamic fashion.

#### ***Response to Arguments***

10. Applicant's arguments with respect to claims 1-34 made in the Applicant's amendment mailed on June 14, 2004 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Pretz (US Patent 6,014,658) (January 11, 2000) Using a Database for Managing Solutions to Problems

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is

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(703) 305-4878. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065. The fax phone number for the Patent Office where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

N. Subramanian  
February 5, 2005

Handwritten signature of Jagdish N. Patel in black ink, followed by the date 2/7/05.

Jagdish N. Patel  
Primary Examiner